

REMARKS

Claims 1-26 are pending. Claims 1, 4-6, 21 and 23-25 are amended. No new claims have been added or canceled. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

Claim Rejection under 35 U.S.C 112

Claims 1, 4-6, 21, and 23-25 are rejected under 112, second paragraph, for insufficient antecedent basis. The claims have been amended to overcome this rejection. Therefore, withdrawal of the rejection is requested.

Claim Rejection under 35 U.S.C. § 103

Claims 1-26 stand rejected under 35 U.S.C. §103(e) as allegedly being unpatentable over U.S. Patent 6,704,541 to Ciarallo et al. (hereinafter “Ciarallo”) in view of U.S. Patent Application Publication No. 2002/0103882 to Johnston et al. (hereinafter “Johnston”) Applicants respectfully traverse this rejection on the following basis.

1. Ciarallo and Johnston fail to teach or suggest all of the features of claims 1-26.

One aspect of the invention relates to determining the courses with which a user is associated and transmitting this information to the user’s client system so that a user may make a selection for a list of courses in order to access the exercises of the selected course (See Applicants’ Specification at least at pg. 7, line 28- pg. 8, line 7).

Claim 1 recites, among other things, “receiving a request ...wherein the request includes user information, accessing a *course* database to determine one or more *courses associated with a user*, based on user information, transmitting a *list of courses* associated with the user to the client system...receiving data indicating selection of a *user-selected course from the list of courses*...transmitting a list of exercises associated with the *selected course*.” Claims 7, 11, 16,

and 21 recite similar features. At least these features are not taught or suggested by Ciarallo and Johnston.

Ciarallo discloses a method for tracking the progress of students in a distance learning environment wherein students can compare their progress with other students in the course (See Ciarallo at Abstract). Ciarallo, however, fails to disclose accessing a course database to determine *courses associated with the user*, transmitting a *list of courses associated with the user*, selection of a *user-selected course from the list of courses*, and transmitting a *list of exercises associated with the selected course*. Rather, Ciarallo discloses a student accessing a course site directly (see Ciarallo, *e.g.*, col. 7, lines 23-27). This is not the same as what is claimed. Furthermore, the Ciarallo fails to disclose each exercise on the list associated with one or more virtual machines.

The Examiner admits that Ciarallo does not teach the one or more virtual machines. The Examiner attempts to combine Ciarallo with Johnston to make up for these deficiencies. However, the combination of Ciarallo with Johnston (assuming arguendo that the combination is proper) still does not suggest at least the claim feature of “accessing a *course* database to determine one or more *courses* associated with a user...transmitting a *list of courses* associated with the user to the client system...receiving data indicating selection of a *user-selected course from the list of courses*...transmitting a list of exercises associated with the *selected course*” as recited above. The cited portions of Johnston relate to a distance learning method wherein a user can connect to a web server to perform *an exercise* but does not disclose the above-referenced features, as claimed. Thus, even the combination of Ciarallo with Johnston does not teach and/or suggest all of the features of at least claims 1, 7, 11, 16, and 21. As such, claims 1, 7, 11, 16, and 21 are patentable over Ciarallo with Johnston.

2. The 103 rejection is improper.

The Examiner legally erred in rejecting claims 1-26 under 35 U.S.C. §103(a). Claims 1-26 are patentable for *at least* the reasons that: (1) the Examiner relies on non-analogous art for the rejection; and (2) assuming arguendo that the art is not deemed non-analogous, there is no legally proper teaching, suggestion, or motivation to modify Ciarallo to include the teachings of Johnston. The Examiner's reliance on Ciarallo with Johnston is improper as these references are non-analogous art to Appellants' claimed invention.

a. Ciarallo is non-analogous art.

A two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is "within the field of the inventor's endeavor." Second, assuming the reference is outside that field, it must be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. (BNA) 313, 315 (Fed. Cir. 1986).

The Examiner has not established that at least Ciarallo is analogous art. The inventor's field of endeavor for claims 1-26 relates to providing one or more distance learning courses with respective exercises in an environment where information technology (IT) training courses can be successfully taught by combining virtual machine technology, remote display technology and web technology. *See* Specification, *e.g.*, pg. 2, lines 14-19.

Ciarallo states that the field of endeavor relates to a system and method for tracking the progress of students in a course and comparing that progress to the progress of other students in the class. *See* Ciarallo, *e.g.*, col. 1, lines 6-10. This is a very different field of endeavor.

Since at least Ciarallo is outside the inventor's field of endeavor, the inquiry becomes whether this reference is reasonably pertinent to the particular problem(s) with which Appellants were involved. It is not. These problems included providing one or more IT related courses that are usually not well suited for distance learning environments due to technical implementation issues (solved by using virtual machines).

Ciarallo is more concerned with the problem of distance learning programs inability to simulate a classroom atmosphere where students are motivated by the performance of their peer students. *See* Ciarallo, *e.g.*, col. 1, lines 31-33. These are very different problems with very different solutions.

The Examiner has not established that a person having ordinary skill in the art would reasonably have been expected to solve the problem(s) of providing one or more IT related courses that are usually technically not well suited for distance learning environments, by considering the problem(s)/solution of Johnston. The Final Office Action is devoid of any evidence to support the Examiner's position.

- b. There is no legally proper teaching, suggestion, or motivation to modify Ciarallo to include the teachings of Johnston.

Assuming arguendo that Ciarallo is deemed analogous, there is no legally proper teaching, suggestion, or motivation to modify Ciarallo to include the teachings of Johnston. In the Final Action, at pg. 3, the Examiner concedes that Ciarallo "fails to explicitly teach wherein each exercise on the list is associated with one or more virtual machines." The Examiner relies on Johnston, however, for this missing element, alleging that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ciarallo and Johnston for the purpose of providing a virtual environment for implementing remote student-access of exercise; because it would provision live and interactive communication for

accessing and completing exercises in one or more simultaneous executions environments over the Internet. See Final Office Action at pg. 3, last paragraph.

This is legally improper. The Examiner's general recitation that a virtual environment would provision live and interactive communications for completing exercises does not adequately address why it would have been obvious to modify the particular system and method of Ciarallo to include the virtual environments. Moreover, in a majority of the embodiments of Ciarallo, a progress over the extended time period of a course is tracked in order to evaluate a students progress during the span of a course. See *Ciarallo*, e.g., col. 4 lines 16-30. In fact, Johnston teaches away from tracking progress during a course. Johnston states:

This particular arrangement is beneficial in that any changes a student makes to a virtual machine is stored locally on the DLU during the training session but are discarded when the session is over. See Johnston at ¶0046.

Thus, since Johnston discards student's activity after the session is over, this teaches away from tracking student progress during the duration of a course (e.g., semester, quarter long course). For *at least* this reason, neither Ciarallo, Johnston, nor the knowledge generally available to one of ordinary skill in the art, provide a legally proper teaching, suggestion, or motivation to modify Ciarallo to include the teachings of Johnston.

For at least the reasons set forth above, the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. §103. Accordingly, the rejection of claims 1-26 is improper and should be reversed.

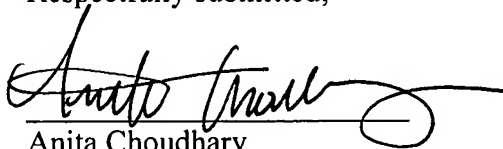
Independent claims 1, 7, 11, 16, and 21 are patentable over Ciarallo in view of Johnston for at least the reasons provided above. Additionally, claims 2-6, 8-10, 12-15, 17-20, and 22-26 depend from and add features to one of the independent claims. As such, these claims are not anticipated by Johnston at least due to their dependency.

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: January 19, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Anita Choudhary", written over a horizontal line.

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